

PATENT

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Date: 2-17-03

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Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Saeed Shafiyar-Rad, *et al.*

Serial No: 09/590,922

Filing Date: June 9, 2000

Title: MULTI-ANGLE VIEWABLE INDICATOR APPARTUS

Examiner: P. Nguyen

Art Unit: 2632

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REPLY BRIEF

Dear Sir:

Applicant submits this reply brief in response to the Examiner's Answer mailed
December 16, 2002.

REMARKS

- A. *The Piber patent fails to disclose at least one elongated strip of substantially translucent material extending through a first side and at least one of second and third sides so that part of the strip is visible at the first side and the at least one of the second and third sides through which the strip extends.*

In the Examiner's Answer, the Examiner contended:

Piber teaches at least one elongated strip of substantially translucent material 34c extending through the first side and at least one of the second and third side so that part of the strip is visible at the first side (figure 4, col. 3, lines 61-62).

Applicants disagree. Piber merely teaches an insert that extends through only *one side* of an operating handle, *from which is it visible*; rather than extending through at least two sides of a housing, from which it is visible, as required by the present claims. In Piber, the insert projects beyond the outer end of the handle such that the "head portion 34c thus appears as an illuminated bar at the tip of the handle" (col. 3, lines 61-62). The inner flat end of the insert, although it projects beyond the tunnel at the other end, remains in the interior of the housing; and thus, is not visible. (Col. 3, lines 19-42.) Thus, as shown in Figs. 2 and 4 of the Piber patent, the insert extends through one end of a tunnel formed in a handle, but does not *extend through* at least two different sides of the housing so as be visible from the at least two different sides through which it also extends.

The Federal Circuit has consistently held that claim terms are given their ordinary and customary meaning in the field of the invention, unless a special definition is clearly stated in the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995) (in banc), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384, 38 USPQ2d 1461 (1996). Moreover, in construing the ordinary meaning of the term "extend through", the Federal Circuit has held that "extend through" means more than merely "engage". In particular, in *Wright Medical Tech. v. Osteonics Corp.*, 122 F.3d 1440, 43 U.S.P.Q.2D (BNA) 1837 (Fed. Cir. 1997), the court construed the words "extend through" to require that a rod pass through an entire length of an isthmus. Thus, it is submitted that the Examiner cannot rely on an insert which forms a tip of a handle as being equivalent to a translucent material which *extends through* at

least two side of a housing.

The Examiner further contended in the Examiner's Answer:

... Piber teaches the second side 34e is also visible as shown in figure 4, col. 4, lines 9-14.

However, as described in the section relied upon by the Examiner (col. 4, lines 9-14), reference numeral 34e is directed to a triangular hole "formed through head portion 34c of the insert to scatter emergent light rays and enhance side illumination of the tip of the handle." Thus, the Examiner fails to show a second side of a housing through which a translucent material extends and from which is also visible. Triangular hole 34e cannot be relied upon as a second side of the insert.

Because the Piber patent does not disclose every structural and functional feature of the subject claims, Piber does not anticipate such claims. Accordingly, a reversal of the rejection is respectfully requested.

B. Both the Piber patent and the Schneider patent, alone and in combination, fail to teach or suggest a light source being activated based on an operating condition of a proximity sensor system.

The Examiner conceded that Piber does not disclose a proximity sensor; and thus, relied on Schneider to teach a proximity sensor. However, the Piber patent and the Schneider patent cannot be combined because there is not proper motivation to combine the teachings of Piber with the teachings of Schneider. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The Piber patent is directed to illuminated electric switches and the problems associated with such switches, such as the intensity of the illumination, the difficulties of relamping, and interchangeability of the operating handle. Thus, Piber does not refer to any problem that would have suggested to one of ordinary skill in the art to use a proximity switch in combination with the illuminated electric switch of Piber. Likewise, the teachings of the Piber patent would not have suggested to one of ordinary skill in the art to use a proximity switch in combination with the illuminated electric switch, as taught in Piber.

The Examiner contended:

...it would have been obvious to the skilled artisan to combine the teachings of Piber and Schneider *et al.* so that an indicator with structure of Piber could have indicated proximity status in order to allow a proximity detection to have been indicated using less dazzling light that would have been more particularly directed to a specific area of concern.

However, Piber is directed to illuminated electric switches having a pivotal operating handle, such a tab switches, toggle lever switches, rocker switches, etc. Such switches are not concerned with detecting the presence or absence of an object. Moreover, Piber is concerned with increasing an intensity of light. One of ordinary skill in the art would not have looked to employing a proximity sensor to use "less dazzling light", as contended by the Examiner. Further, Schneider *et al.* is a design patent depicting a particular ornamental design of a proximity sensor having what appear to be light emitting diodes (LEDs) protruding from a chamfered corner of the sensor. Schneider *et al.* includes no moveable handle or switch; nor is Schneider *et al.* concerned with varying an intensity of the LEDs. Accordingly, it appears that the purported combination of references is based on improper hindsight, in which the present application provides the teaching and motivation to do so.

For the aforementioned reasons, the present invention is non-obvious over Piber and Schneider *et al.*, taken individually or in combination. Accordingly, a reversal of the rejection is respectfully requested.

CONCLUSION

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-5, 10-14, and 19-21 be reversed.

In the event any additional fees are due in connection with this paper, authorization to charge Deposit Account No. 50-1063 is hereby granted.

Respectfully submitted,
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